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EXAMINER

GILLIGAN, CHRISTOPHER L

ART UNIT	PAPER NUMBER
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3626

DATE MAILED: 12/26/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/893,495

Applicant(s)

WALKER ET AL.

Examiner

Luke Gilligan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 34-45,50 and 51 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 34-45,50 and 51 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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Claims 34-45, 50, and 51 have been examined.

***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 34-41, and 51 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

3. The basis of this rejection is set forth in a two-prong test of:

(1) whether the invention is within the technological arts; and

(2) whether the invention produces a useful, concrete, and tangible result.

4. For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

5. In the present case, claim 34 only recites an abstract idea. The recited steps of merely establishing an agreement with an expert, transmitting requests to the expert, receiving responses from the expert, and providing compensation to the expert do not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper. These steps only constitute an idea of how to establish and fulfill a business agreement with an expert. In addition, dependent claims 35-41

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contain similar limitations related to the idea of how to establish and fulfill a business agreement with an expert.

6. Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claims 34-41 are deemed to be directed to non-statutory subject matter.

7. Claim 51 contains substantially similar limitations to claim 34 but recites a "computer readable medium encoded with processing instructions" in the preamble. As to technological arts recited in the preamble, mere recitation in the preamble (i.e., intended or field of use) or mere implication of employing a machine or article of manufacture to perform some or all of the recited steps does not confer statutory subject matter to an otherwise abstract idea unless there is positive recitation in the claim as a whole to breathe life and meaning into the preamble. In the present case, none of the recited steps are directed to anything in the technological arts as explained above with the exception of the recitation in the preamble that the method is implemented using a "computer readable medium encoded with processing instructions". Looking at the claim as a whole, nothing the body of the claim recites any structure or functionality to suggest that a computer performs the recited steps. Therefore, the preamble is taken to merely recite a field of use.

### ***Claim Rejections - 35 USC § 112***

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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9. Claims 44 and 45 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

10. Claim 44 recites the limitation "the action to be taken...". There is insufficient antecedent basis for this limitation in the claim. It appears that claim 44 should be dependent upon claim 43 which does recite "an action to be taken". Therefore, for examination purposes, it will be assumed that claim 44 depends on claim 43.

11. Claim 45 recites the limitation "the at least one instruction...". There is insufficient antecedent basis for this limitation in the claim. It appears that claim 45 should be dependent upon claim 43 which does recite "at least one instruction". Therefore, for examination purposes, it will be assumed that claim 45 depends on claim 43.

### ***Claim Rejections - 35 USC § 102***

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

13. Claims 42-45 are rejected under 35 U.S.C. 102(e) as being anticipated by Echerer, U.S. Patent No. 6,046,761.

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14. As per claim 42, Echerer teaches a method, comprising: establishing an agreement with an entity, wherein the entity agrees to continuously monitor physiological parameters through at least one telemetry device in exchange for compensation (see column 2, lines 18-24 and column 3, lines 32-34); wearing the at least one telemetry device (see column 2, lines 2-4); receiving an indication from the entity that an anomaly has occurred in at least one of the physiological parameters (see column 3, lines 34-43); and receiving a diagnosis based on the anomaly (see column 4, lines 55-58).

15. As per claim 43, Echerer teaches the method of claim 43 as described above, wherein the step of receiving a diagnosis comprises: receiving a diagnosis based on the anomaly, wherein the diagnosis includes at least one instruction regarding an action to be taken in accordance with the diagnosis (see column 6, lines 28-31).

16. As per claim 44, Echerer teaches the method of claim 43 as described above, wherein the action to be taken comprises: an action to be taken by the entity (see column 7, lines 1-5).

17. As per claim 45, Echerer teaches the method of claim 43 as described above, wherein the at least one instruction comprises: an instruction to take a medication (see column 6, lines 28-31).

### ***Claim Rejections - 35 USC § 103***

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

19. Claims 34-41, 50 and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mayaud, U.S. Patent No. 5,845,255 in view of Shults et al., U.S. Patent No. 6,324,516.

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20. As per claim 34, Mayaud teaches a method comprising: transmitting, during a time period, a plurality of requests to an expert, wherein each request comprises a request for a diagnosis of a physiological anomaly associated with a patient (see column 19, lines 17-24); and receiving, from the expert, a response to each of the requests, the response to each request being a diagnosis for the patient of the request (see column 20, lines 20-31). Mayaud do not explicitly teach establishing an agreement with the expert, wherein the agreement specifies a periodic compensation amount that the expert will receive in exchange for providing a minimum number of diagnoses during a time period; and causing the compensation amount to be provided to the expert if, at the end of the time period, it is determined that the expert has provided the minimum amount of diagnoses during the time period. Shults teaches establishing an agreement with an expert, wherein the agreement specifies a compensation amount that the expert will receive in exchange for providing an agreed upon quantity and nature of medical treatments (see column 1, lines 51-56); and causing the compensation amount to be provided to the expert if it is determined that the expert has provided the agreed upon nature and quantity of treatment (see column 1, lines 63-67). It would have been obvious to one of ordinary skill in the art of patient billing at the time of the invention to incorporate the billing and payment scheme of Shults et al. into the system of Mayaud based on the tracking of diagnoses performed by physicians. One of ordinary skill in the art would have been motivated to include such a billing and payment scheme into the system of Mayaud for the purpose of saving patients money on medical costs by providing negotiating power over medical procedures.

21. Claim 50 contains substantially similar apparatus limitations to method claim 34 and, as such, is rejected for similar reasons as given above.

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22. Claim 51 contains substantially similar method limitations embodied on a computer readable medium to method claim 34 and, as such, is rejected for similar reasons as given above.

23. As per claim 35, Mayaud in view of Shults et al. teach the method of claim 34 as described above. Mayaud further teaches selecting the expert from a plurality of remote experts based on a received anomaly and an agreement (see column 21, lines 34-41).

24. As per claim 36, Mayaud in view of Shults et al. teach the method of claim 34 as described above. Shults et al. further teach causing a reduced compensation amount to be provided to the expert if at the end of the time period, it is determined that the expert has not provided the minimum amount of diagnoses during the time period (see column 1, lines 54-56, it is assumed that ensuring that the agreements have been honored could include providing a reduced payment amount if the agreements are not honored). It would have been obvious to one of ordinary skill in the art of patient billing to incorporate this feature into the invention of Mayaud for the reasons given above with respect to claim 34.

25. As per claim 37, Mayaud in view of Shults et al. teach the method of claim 34 as described above. Shults et al. further teach causing the compensation amount to be withheld from the expert if, at the end of the time period, it is determined that the expert has not provided the minimum amount of diagnoses during the time period (see column 1, lines 54-56, it is assumed that ensuring that the agreements have been honored would include withholding payment if the agreements are not honored). It would have been obvious to one of ordinary skill in the art of patient billing to incorporate this feature into the invention of Mayaud for the reasons given above with respect to claim 34.

26. As per claim 38, Mayaud in view of Shults et al. teach the method of claim 34 as described above. Mayaud further teach incrementing a stored number of diagnoses provided



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by the expert during the time period when the diagnosis is received (see column 42, lines 38-53).

27. As per claim 39, Mayaud in view of Shults et al. teach the method of claim 38 as described above. Mayaud further teaches determining that the diagnosis provided is associated with at least one factor that indicates a complication in providing the diagnosis (see column 42, lines 38-42); and indicating in the stored diagnoses the at least one factor (see column 42, lines 38-42). In addition, it is assumed that one of ordinary skill in the art would want to give a heavier weight to more complicated diagnoses by. Since the system of Mayaud tracks the number and nature of diagnoses by a particular physician, it is assumed that the more complicated diagnoses could be flagged in the record.

28. As per claim 40, Mayaud in view of Shults et al. teach the method of claim 39 as described above. Mayaud further teaches the at least one factor that indicates a complication in providing the diagnosis comprises at least one of: i) a greater than average complexity in the anomaly, ii) a greater than average amount of time required to provide the diagnosis, iii) an identification that the expert communicated directly with the patient, and iv) an indication that the patient's life was saved due to the diagnosis (see column 42, lines 38-53).

29. As per claim 41, Mayaud in view of Shults et al. teach the method of claim 40 as described above. Mayaud further teaches providing to the expert, at least once during the time period, an indication of a current number of diagnoses provided (see column 42, lines 50-53).

### ***Conclusion***

30. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Selker teaches a clinical reporting system that tracks patient information.

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31. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luke Gilligan whose telephone number is (703) 308-6104. The examiner can normally be reached on Monday-Friday 8am-5:30pm.

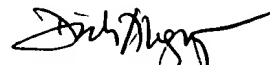
32. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (703) 305-9588. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

33. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.



CLG

December 20, 2002



DINH X. NGUYEN  
PRIMARY EXAMINER